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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/048,123	12/03/2001	Paul David James Blackler	P32292	2730

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[REDACTED] EXAMINER

ROBINSON, BINTA M

ART UNIT	PAPER NUMBER
1625	[REDACTED]

DATE MAILED: 09/10/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	10/048,123	BLACKLER ET AL.
	Examiner Binta M. Robinson	Art Unit 1625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on \_\_\_\_.  
 2a) This action is FINAL.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.  
**Disposition of Claims**  
 4) Claim(s) 1-10 and 14 is/are pending in the application.  
     4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_ is/are allowed.  
 6) Claim(s) 1-10 and 14 is/are rejected.  
 7) Claim(s) \_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 11) The proposed drawing correction filed on \_\_\_\_ is: a) approved b) disapproved by the Examiner.  
     If approved, corrected drawings are required in reply to this Office action.  
 12) The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All b) Some \* c) None of:  
     1. Certified copies of the priority documents have been received.  
     2. Certified copies of the priority documents have been received in Application No. \_\_\_\_.  
     3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
     \* See the attached detailed Office action for a list of the certified copies not received.  
 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
     a) The translation of the foreign language provisional application has been received.  
 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). ____
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>3</u> .	6) <input type="checkbox"/> Other: _____

### Detailed Action

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim(s) are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

A. Claim 3 recites the limitation "Figure II" in line 2, page 1 of the amendment 7A.

There is insufficient antecedent basis for this limitation in the claim.

B. Claim 2 recites the limitation "Figure I" in line 2, page 11. There is insufficient antecedent basis for this limitation in the claim.

C. Claim 4 recites the limitation "Figure III and/or Table I" in line 2, page 2 of the amendment 7A. There is insufficient antecedent basis for this limitation in the claim.

D. Claim 5 recites the limitation "Figure IV and/or Table II" in line 2, page 2 of the amendment 7A. There is insufficient antecedent basis for this limitation in the claim.

E. In claim 9, page 11, line 1, the phrase "characterized in" is indefinite. The term "wherein" is suggested.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

invention was made to a person having ordinary skill in the art to which said subject matter pertains.

Patentability shall not be negated by the manner in which the invention was made.

Claims 1-10, 14 are rejected under 35 U. S. C. 103(a) as being unpatentable over Patel (See Reference N). Patel, al. teaches the instant compound, 5-[4[2-(N-,ethyl-N-2-pyridyl)amino)ethoxy]Benzyl]Thiazolidine-2, 4-dione. At pages 1-13, see the instant compound

The difference between the prior art compound and the instantly claimed compound is that the claimed compound is a polymorph of the Patel compound. A polymorph is a solid crystalline phase of a given compound resulting from the possibility of at least two different arrangements of the molecules of that compound in the solid state. The instant compound discloses the infrared spectrum, Raman spectrum, NMR, and X-ray diffraction pattern for 5-[4[2-(N-,ethyl-N-2-pyridyl)amino)ethoxy]Benzyl]Thiazolidine-2, 4-dione. The Patel reference does not disclose such data for 5-[4[2-(N-,ethyl-N-2-pyridyl)amino)ethoxy]Benzyl]Thiazolidine-2, 4-dione.

It would have been obvious to one of ordinary skill in the art to create a polymorph of the infra red spectrum, Raman spectrum, NMR, and X-ray diffraction pattern for 5-[4[2-(N-,ethyl-N-2-pyridyl)amino)ethoxy]Benzyl]Thiazolidine-2, 4-dione that does not show unexpected properties from the known compound. Accordingly, the compounds are deemed unpatentable there from in the absence of a showing of unexpected results for the claimed compounds over those of the generic prior art compounds.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Binta M. Robinson whose telephone number is (703) 306-5437. The examiner can normally be reached on M-F (9:30-6:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alan Rotman can be reached on (703)308-4698. The fax phone numbers for the organization where this application or proceeding is assigned are (703)308-7922 for regular communications and (703)308-7922 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-0193.

Binta Robinson

September 8, 2002

*Alan L. Rotman*  
ALAN L. ROTMAN  
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